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Remarks

Preliminary comments

The Remarks and arguments, as well as the cited case law, put forth in the Response filed on January 23, 2001 to the Office action of September 20, 2000 are incorporated herein by reference.

The Applicant would like to again emphasize that quite small differences between one golf club and another can have a significant effect on a golfer's ability to hit a golf ball and achieve a desired distance and accuracy. Beyond merely designing a single club so that it achieves a desired result, the greater goal is to design a set of golf clubs that allow a golfer to use a consistent swing regardless of the club being used, yet achieve the desired performance results. Given the large number of factors which can be varied, and the range of variability, the choice of a particular set of dimensions and variances for a set of golf clubs is virtually infinite. Any resulting selection of design parameters is more than a mere design selection, and involves a considerable amount of theoretical application and testing to verify that the resultant club or set of clubs achieves the desired results. The large number of issued patents claiming small differences in golf club designs, both in individual clubs and in sets of clubs, attests to the non-obviousness of these differences. The Applicant believes that the set of parameters he has identified by virtue of the claims in the instant patent application result in a novel, non-obvious set of golf clubs which achieve a particular beneficial result for golfers using the club set. Against this background, the Applicant again respectfully requests that the Examiner please

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1 consider carefully the following arguments in favor of allowing the claims as  
2 presented and amended.

3  
4 Rejection of claims under 35 U.S.C. § 112.

5 Claims 1-25 have been rejected under 35 U.S.C. § 112, first paragraph. (Ref.  
6 paragraphs nos. 4 and 5 of the Office action.)

7 The Applicant respectfully disagrees that claims 1-25 do not meet the  
8 requirements of 35 U.S.C. § 112, first paragraph. In the first place, no specific reason  
9 is given as to why the amended and new claims are not enabled by the specification.

10 As stated by the Court in *In re Wright*, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993),  
11 "[w]hen rejecting a claim under the enablement requirement of Section 112, the  
12 [Patent Office] bears an initial burden of setting forth a reasonable explanation as  
13 to why it believes that the scope of protection provided by the claims is not  
14 adequately enabled by the description of the invention provided in the specification  
15 of the application; this includes, of course, providing sufficient reasons for doubting  
16 any assertions in the specification as to the scope of enablement." (Emphasis  
17 added.) Beyond the lack of reasons provided by the Examiner for this rejection, the  
18 Applicant contends that the specification well supports the amended claims.  
19 Specifically, Table 1 (page 9 of the specification) and Table II (page 10) describe an  
20 exemplary set of golf clubs having 13 clubs in the set. This provides sufficient basis  
21 for a first, a second, a third, a fourth (and so on, up to at least a thirteenth) club. The  
Applicant notes that there is no statutory requirement (or any requirement imposed  
by the Courts) that the claims contain verbiage which is found *ipsissimis verbis* (i.e.,  
word-for-word) in the specification. Accordingly, although the specification may not

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1 expressly recite "a fourth" or a "fifth" golf club, they are inherently shown in the  
2 Tables I and II.

3 Further, Table I shows 2 adjacent clubs (for example, the 4-iron and the 5-iron)  
4 with a shaft length difference of 0.75 inches, which is "at least about 0.6 inches  
5 longer than a second adjacent golf club in the set". Table I also shows 2 adjacent  
6 clubs (for example, the 9-iron and the pitching wedge) with a shaft length difference  
7 of 0 inches, which is "less than 0.6 inches longer than a fourth adjacent golf club in  
8 the set". Further, a club shaft length variance of 0.72 inches is supported by the  
9 specification, as evidenced at page 3, lines 13-14 ("Preferably, the club lengths  
10 generally vary by between about 0.6 inches (15.24 mm) and 1 inch (25.4 mm)  
11 between adjacent clubs in the set.") Certainly, 0.72 inches is "between 0.6 inches  
and 1 inch".

12 Moreover, the rejection as stated in paragraph 4 of the office action seems to be  
13 more of a 35 U.S.C. § 112, second paragraph rejection, since the word "enablement"  
14 is never even used in this rejection. That is, the Examiner contends that the  
15 specification does not contain support for the claims, not that the specification is  
16 non-enabling. As explained above, the Applicant contends that the claimed  
limitations are well supported by the specification.

17 With respect to the Section 112, first paragraph, rejection at paragraph 5 of the  
18 Office action, the Applicant contends that one skilled in the art would certainly  
19 understand how to construct a set of golf clubs having the limitations set forth in the  
20 claims. The Applicant is at a loss to understand how one skilled in the art would be  
21 unable to construct a set of golf clubs wherein two of the adjacent clubs have a shaft  
length difference of greater than about 0.6 inches, and two other clubs in the set

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1 have a shaft length difference of less than 0.6 inches. The same comments apply  
2 equally to constructing a set of clubs with the claimed lie angle variances and club  
3 head weight variances. Constructing the clubs, once the dimensional criteria are  
4 determined, is fundamental. It is selecting the criteria which comprises the novelty,  
5 and the Applicant has certainly identified those criteria which result in a novel set of  
6 golf clubs.

7 With respect to the Section 112, second paragraph, the Examiner states that the  
8 recitation of "at least about" in claims 1 and 15 is indefinite. However, as the Court  
9 recently stated in *Ecolab Inc. v. Envirochem Inc.*, Fed. Cir. No. 00-1402, 9/6/01, the  
10 term "about" is commonly used to avoid a strict numerical boundary, and is thus not  
11 indefinite under Section 112.

12 For these reasons the Applicant believes that claims 1-25 are fully enabled by  
13 the written description, and are not indefinite. Accordingly, the applicant requests  
14 that the rejection of these claims under 35 U.S.C. § 112 be removed.

15 Rejection of claims under 35 U.S.C. § 102.

16 (Ref. paragraph number 9 of the office action.) The Examiner has repeated the  
17 earlier rejection of independent claims 1 and 15 (and the claims which depend  
18 therefrom) as being anticipated by Kajita et al. (U.S. Patent No. 4,840,380) under 35  
19 U.S.C. § 102(b). Further, at page 13 (second paragraph) of the Office action, the  
20 Examiner has rejected the arguments put forth in the January 23, 2001 to the Office  
21 action of September 20, 2000. In that paragraph, the Examiner states that the  
Applicant essentially admits in the Response (at page 7, lines 10-12, and at page 8,  
lines 9-15) that Kajita et al. disclose a set of golf clubs having both a variance between

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1 two adjacent clubs of greater than about 0.6 inches (for claim 1) (or 1.2 inches, for claim  
2 15), and a variance of less than 0.6 inches (for claim 1) (or 1.2 inches, for claim 15) for  
3 two other adjacent clubs in the set. This is not correct. In fact, at page 8, lines 9-10,  
4 the Applicant specifically and incontrovertibly states that Kajita et al. disclose sets of golf  
5 clubs. Line 11 discloses that Kajita et al. describe one set of golf clubs with a shaft  
6 length variance between adjacent clubs of greater than about 0.6 inches; and line 13  
7 discloses that Kajita et al. describe another set of golf clubs with a shaft length variance  
8 between adjacent clubs of less than 0.6 inches. These are obviously different sets of  
9 golf clubs - not the same set.

10 As previously noted in the January 23, 2001 Response, the PTO and the Federal  
11 Circuit provide that "[a]nticipation requires that all of the elements and limitations of the  
12 claims are found within a single prior art reference." (*Scripps Clinic and Research*  
13 *Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir.  
14 1991 (emphasis added)). Claims 1 and 15 include the limitation that a first and a second  
15 club vary in club length by greater than about 0.6 inches, and that a third and a fourth  
16 club vary in club length by less than 0.6 inches. This limitation is not found in Kajita et  
17 al., as described above. Accordingly, the Applicant contends that claims 1 and 15 (and  
18 the claims which depend therefrom) recite novel limitations not found within Kajita et al.,  
19 and the Applicant therefore respectfully requests that the rejection of these claims as  
20 being anticipated by Kajita et al. be removed.

21 Although no rejection of claims 1-25 under 35 U.S.C. § 103 was made in the April  
11, 2001 Office action, the Applicant would like to address that issue at this time in the  
hopes of forestalling any such rejection in the future. As previously stated, Lundberg

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1 merely discloses a difference in club length of 0.5 inches (see column 4, lines 44-  
2 45), which is a length less than that disclosed by Kajita, and therefore even less  
3 relevant to the Applicant's claims than Kajita. Peters merely discloses that varying  
4 the shaft length and the lie angle of a golf club can have an effect on golf club  
5 performance, but does not disclose any particular club length increments. Adams  
6 discloses that the inertia of a golf club head is a function of the length and weight of  
7 the club head, but does not disclose any particular length increments which produce  
8 a particularly beneficial effect. Sherwood discloses a difference in lie angle between  
9 clubs of 0.5 degrees. Chen et al. ('138) refer to "shafts decreasingly shortened"  
10 (column 1, lines 16-17), but does not state any dimensional variances. Nishizawa  
11 ('198) shows a set of clubs (Fig. 1) where, "a shaft length . . . becomes shorter  
12 gradually as the club number becomes larger" (column 2, lines 35-39), but again, no  
13 dimensional limitations are stated. Accordingly, if these references are combined,  
14 the result is a teaching that club lengths can be varied, and by 0.5 inches between  
15 clubs, and the lie angle and weight of a club head can be varied (0.5 degrees in the  
16 case of the lie angle), to produce different performance results in a golf club. The  
17 latter two points (varying club length and varying lie angle) are nothing more than is  
18 well known in the art. However, none of these references teach or suggest using a  
19 club length increment between adjacent clubs of 0.6 inches (claim 1) (or 1.2 inches  
20 in a set of alternating clubs, as in claim 15). Further, none of these references teach  
21 or suggest a set of golf clubs containing the just-described limitation(s), or the  
limitation that two other adjacent clubs have a club length increment between the clubs  
of less than 0.6 inches (in the case of claim 1, or less than 1.2 inches in the case of  
claim 15).

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1 Therefore, the Applicant contends that claims 1-25 recite novel, non-obvious  
2 limitations over Lundberg, Peters, Adams, Sherwood, Chen and Nishizawa.

3  
4 Request for Extension of Time

5 The Applicant hereby requests a three (3) month extension of time under 37  
6 C.F.R. § 1.136 to file this CPA in respond to the Office action, to and through  
7 October 11, 2001. The extension fee under 37 C.F.R. § 1.17(a)(3) is enclosed  
8 herewith.

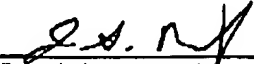
9 Summary

10 The Applicant believes that the above response is a complete response to the  
11 Office action of April 11, 2001, and therefore requests timely allowance of the  
12 claims.

13 Respectfully submitted,

14 Randy Henry, Applicant

15 October 10, 2001

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